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EXAMINER
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LAZARO, DAVID R

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 07/12/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/749,587

Applicant(s)

DOOLEY, THOMAS P.

Examiner

David Lazaro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 48-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-47, drawn to a system and method for providing an information network, classified in class 709, subclass 217.
  - II. Claims 48-53, drawn to a method for enhancing probability of high placement of a webpage by a search engine, classified in class 707, subclass 5.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as increasing the probability that a webpage will be highly ranked by a search engine.

See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Jonathon Bockman (45,640) on July 1, 2004 a provisional election was made without traverse to prosecute the invention of I, claims 1-47. Affirmation of this election must be made by applicant in replying to this

Office action. Claims 48-53 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Papers Received***

5. Fees, Oath/Declaration and Small entity status were received 02/20/01 (Paper #3).
6. Substitute drawings received 02/20/01 (Paper #4).
7. Preliminary Amendment A received 02/20/01 (Paper #5).
8. Change of Address received 11/26/01 (Paper #7).
9. Change of Address received 06/17/03 (Paper #8).

***Information Disclosure Statement***

10. The information disclosure statement (IDS) submitted on 03/13/01 (Paper #6) has been considered by the examiner.

***Priority***

11. This application claims the benefit of 60/176024 (filed 01/14/00) and 60/220555 (filed 07/25/00).

***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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13. Claims 9 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Claims 9 and 30 both recite the limitation "the prefix or suffix". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

16. Claims 1-23 and 25-45 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,125,395 by Rosenberg et al. (Rosenberg).

17. The examiner notes an instance of the invention disclosed by Rosenberg was instantiated as a website on the Internet (piiq.com) that was officially launched in

August, 1999 according to a Business Wire article (Please see pertinent art in the Conclusion of this Office Action for full citation).

18. With respect to Claim 1, Rosenberg teaches a system for providing an information network on the Internet (Col. 3 lines 44-52), comprising: a plurality of websites (Col. 6 lines 52-63), each website comprising a category (Col. 6 lines 52-63), information about the category (Col. 6 lines 52-63) and a domain name that corresponds to the category (Col. 6 lines 52-63); and at least one redirect assigned to each website (Col. 6 lines 8-23), each redirect comprising a URL redirect that directs at least one of a browser and a server to the assigned website (Col. 6 lines 8-23 and lines 40-50).

19. With respect to Claim 2, Rosenberg teaches all the limitations of Claim 1 and further teaches the redirect further comprises at least one of a redirect domain name, a website, and a webpage (Col. 6 lines 8-23).

20. With respect to Claim 3, Rosenberg teaches all the limitations of Claim 1 and further teaches wherein each of the websites further comprise at least one webpage (Col. 5 line 63 - Col. 6 line 7).

21. With respect to Claim 4, Rosenberg teaches all the limitations of Claim 1 and further teaches wherein the domain name comprises: a top-level domain (Col. 1 lines 36-43); and at least one of a descriptive term (Col. 54 lines 26-34), a simple term (Col. 5 lines 26-34), and an abbreviation corresponding to the category (Col. 5 lines 26-34 and Col. 2 lines 3-12).

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22. With respect to Claim 5, Rosenberg teaches all the limitations of Claim 4 and further teaches wherein the domain name further comprises at least one of a hyphen, a prefix, and a suffix (Col. 5 lines 26-34, Col. 1 lines 44-49, Col. 2 lines 3-12).

23. With respect to Claim 6, Rosenberg teaches all the limitations of Claim 5 and further teaches the prefix of suffix is selected from the group consisting of a letter, a term, and a number (Col. 5 lines 26-34, Col. 1 lines 44-49, Col. 2 lines 3-12).

24. With respect to Claim 7, Rosenberg teaches all the limitations of Claim 2 and further teaches wherein the redirect domain name comprises: a top-level domain (Col. 1 lines 36-43); and at least one of a descriptive term (Col. 5 lines 26-34), a simple term (Col. 5 lines 26-34), and an abbreviation corresponding to the category (Col. 5 lines 26-34 and Col. 2 lines 3-12).

25. With respect to Claim 8, Rosenberg teaches all the limitations of Claim 7 and further teaches wherein the redirect domain name further comprises at least one of a hyphen, a prefix, and a suffix (Col. 5 lines 26-34, Col. 1 lines 44-49, Col. 2 lines 3-12).

26. With respect to Claim 9, Rosenberg teaches all the limitations of Claim 7 and further teaches the prefix of suffix is selected from the group consisting of a letter, a term, and a number (Col. 5 lines 26-34, Col. 1 lines 44-49, Col. 2 lines 3-12).

27. With respect to Claim 10, Rosenberg teaches all the limitations of Claim 1 and further teaches wherein the websites contain a plurality of links (Col. 5 lines 40-46).

28. With respect to Claim 11, Rosenberg teaches all the limitations of Claim 10 and further teaches wherein the links are internal to the information network (Col. 6 lines 8-14)

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29. With respect to Claim 12, Rosenberg teaches all the limitations of Claim 10 and further teaches wherein the links originate from outside the information network (Col. 6 lines 8-14).

30. With respect to Claim 13, Rosenberg teaches all the limitations of Claim 1 and further teaches a search engine (Col. 6 lines 8-23).

31. With respect to Claim 14, Rosenberg teaches all the limitations of Claim 1 and further teaches the information network is a healthcare information network (Col. 4 lines 13-23 and lines 52-56, and Col. 5 lines 50-64 - The examiner interprets healthcare to fall under commercial and offering services and further notes Rosenberg is relevant for any collection of information under a common theme.)

32. With respect to Claim 15, Rosenberg teaches all the limitations of Claim 1 and further teaches the information network is a biomedical information network (Col. 4 lines 13-23 and lines 52-56, and Col. 5 lines 50-64 - The examiner interprets biomedical to fall under commercial and offering services and further notes Rosenberg is relevant for any collection of information under a common theme.)

33. With respect to Claim 16, Rosenberg teaches all the limitations of Claim 1 and further teaches wherein the website further comprises at least one of promotional information and advertising information (Col. 4 lines 13-23 and Col. 5 lines 50-64).

34. With respect to Claim 17, Rosenberg teaches all the limitations of Claim 1 and further teaches wherein the website further comprises at least one of product information and service information (Col. 4 lines 13-23 and Col. 6 lines 50-64).



35. With respect to Claim 18, Rosenberg teaches all the limitations of Claim 1 and further teaches at least one information directory comprising at least one of a site map and a plurality of links to the websites (Col. 7 lines 16-25).

36. With respect to Claim 19, Rosenberg teaches all the limitations of Claim 1 and further teaches wherein the websites and domain names are arranged in a hierarchical structure (Col. 3 lines 53-59 and Col. 6 lines 40-63).

37. With respect to Claim 20, Rosenberg teaches all the limitations of Claim 1 and further teaches at least one matrix of information (Col. 6 lines 40-63 and Col. 7 lines 5-25).

38. With respect to Claim 21, Rosenberg teaches all the limitations of Claim 1 and further teaches the information network is deployed by a single entity (Col. 5 lines 50-52).

39. With respect to Claim 22, Rosenberg teaches all the limitations of Claim 1 and further teaches the information network is deployed by a single entity and at least one additional entity (Col. 5 lines 50-52 and lines 35-40 - The examiner notes the registered owner of a domain name can be an individual or any organization.).

40. With respect to Claim 23, Rosenberg teaches all the limitations of Claim 1 and further teaches at least one unused domain name (Col. 5 lines 35-40).

41. With respect to Claim 25, Rosenberg teaches a method for providing an information network on the Internet (Col. 3 lines 44-52), comprising: providing a plurality of websites (Col. 6 lines 52-63); providing each website with a category (Col. 6 lines 52-63), information about the category (Col. 6 lines 52-63), and a domain name that

corresponds to the category (Col. 6 lines 52-63); providing at least one redirect assigned to each website (Col. 6 lines 8-23); and providing each redirect with a URL redirect that directs at least one of a browser and a server to the assigned website (Col. 6 lines 8-23 and lines 40-50).

42. With respect to Claim 26, Rosenberg teaches all the limitations of Claim 25 and further teaches providing the redirect with at least one of a redirect domain name, a website, and a webpage (Col. 6 lines 8-23).

43. With respect to Claim 27, Rosenberg teaches all the limitations of Claim 25 and further teaches providing each of the websites with at least one webpage (Col. 5 line 63 - Col. 6 line 7).

44. With respect to Claim 28, Rosenberg teaches all the limitations of Claim 25 and further teaches wherein the step of providing each website with a category, information about the category, and a domain name that corresponds to the category comprises: providing the domain name with a top-level domain (Col. 1 lines 36-43); and providing the domain name with at least one of a descriptive term (Col. 54 lines 26-34), a simple term (Col. 5 lines 26-34), and an abbreviation corresponding to the category (Col. 5 lines 26-34 and Col. 2 lines 3-12).

45. With respect to Claim 29, Rosenberg teaches all the limitations of Claim 28 and further teaches providing the domain name with at least one of a hyphen, a prefix, and a suffix (Col. 5 lines 26-34, Col. 1 lines 44-49, Col. 2 lines 3-12).

46. With respect to Claim 30, Rosenberg teaches all the limitations of Claim 28 and further teaches the prefix of suffix is selected from the group consisting of a letter, a term, and a number (Col. 5 lines 26-34, Col. 1 lines 44-49, Col. 2 lines 3-12)

47. With respect to Claim 31, Rosenberg teaches all the limitations of Claim 26 and further teaches wherein the step of providing the redirect with at least one of a redirect domain name, a website, and a webpage comprises: providing the redirect domain name with a top-level domain (Col. 1 lines 36-43); and providing the redirect domain name with at least one of a descriptive term (Col. 5 lines 26-34), a simple term (Col. 5 lines 26-34), and an abbreviation corresponding to the category (Col. 5 lines 26-34 and Col. 2 lines 3-12).

48. With respect to Claim 32, Rosenberg teaches all the limitations of Claim 31 and further teaches providing the redirect domain name with at least one of a hyphen, a prefix, and a suffix (Col. 5 lines 26-34, Col. 1 lines 44-49, Col. 2 lines 3-12).

49. With respect to Claim 33, Rosenberg teaches all the limitations of Claim 31 and further teaches the prefix of suffix is selected from the group consisting of a letter, a term, and a number (Col. 5 lines 26-34, Col. 1 lines 44-49, Col. 2 lines 3-12).

50. With respect to Claim 34, Rosenberg teaches all the limitations of Claim 25 and further teaches the step of providing the websites with a plurality of links (Col. 5 lines 40-46).

51. With respect to Claim 35, Rosenberg teaches all the limitations of Claim 34 and further teaches wherein the links are internal to the information network (Col. 6 lines 8-14).

52. With respect to Claim 36, Rosenberg teaches all the limitations of Claim 34 and further teaches wherein the links originate from outside the information network (Col. 6 lines 8-14).

53. With respect to Claim 37, Rosenberg teaches all the limitations of Claim 25 and further teaches providing a search engine (Col. 6 lines 8-23).

54. With respect to Claim 38, Rosenberg teaches all the limitations of Claim 25 and further teaches providing the website with at least one of promotional information and advertising information (Col. 4 lines 13-23 and Col. 5 lines 50-64).

55. With respect to Claim 39, Rosenberg teaches all the limitations of Claim 25 and further teaches providing the website with at least one of product information and service information (Col. 4 lines 13-23 and Col. 6 lines 50-64).

56. With respect to Claim 40, Rosenberg teaches all the limitations of Claim 25 and further teaches providing at least one information directory comprising at least one of a site map and a plurality of links to the websites (Col. 7 lines 16-25).

57. With respect to Claim 41, Rosenberg teaches all the limitations of Claim 25 and further teaches wherein the websites and domain names are arranged in a hierarchical structure (Col. 3 lines 53-59 and Col. 6 lines 40-63).

58. With respect to Claim 42, Rosenberg teaches all the limitations of Claim 25 and further teaches providing at least one matrix of information (Col. 6 lines 40-63 and Col. 7 lines 5-25).

59. With respect to Claim 43, Rosenberg teaches all the limitations of Claim 25 and further teaches the information network is deployed by a single entity (Col. 5 lines 50-52).

60. With respect to Claim 44, Rosenberg teaches all the limitations of Claim 25 and further teaches the information network is deployed by a single entity and at least one additional entity (Col. 5 lines 50-52 and lines 35-40 - The examiner notes the registered owner of a domain name can be an individual or any organization.).

61. With respect to Claim 45, Rosenberg teaches all the limitations of Claim 25 and further teaches providing additional domain names for future use (Col. 6 lines 14-20).

***Claim Rejections - 35 USC § 103***

62. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

63. Claims 24 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenberg in view of U.S. Patent 6,154,744 by Kenner et al. (Kenner).

64. With respect to Claim 24, Rosenberg teaches all the limitations of Claim 1 but does not explicitly disclose at least one mirror website. However, Kenner teaches the common use of mirror websites (Col. 3 lines 49-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the system disclosed by Rosenberg and modify it as indicated by Kenner such that the system

further comprises at least one mirror website. Since mirror websites can improve transmission rates, one would be motivated to have this as it provides a more enjoyable user experience of the website content (Col. 3 lines 49-65 of Kenner).

65. With respect to Claim 46, Rosenberg teaches all the limitations of Claim 1 but does not explicitly disclose providing at least one mirror website. However, Kenner teaches the common use of mirror websites (Col. 3 lines 49-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Rosenberg and modify it as indicated by Kenner such that the method further comprises providing at least one mirror website. Since mirror websites can improve transmission rates, one would be motivated to have this as it provides a more enjoyable user experience of the website content (Col. 3 lines 49-65 of Kenner).

66. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenberg in view of U.S. Patent 6,678,731 by Howard et al. (Howard). Rosenberg teaches all the limitations of Claim 25 but does not explicitly disclose receiving registration information from a user, comprising at least one of a user name, an e-mail address, a mailing address, a URL, and a password. Howard teaches receiving registration information from a user comprising at least one of a user name, an e-mail address, a mailing address, a URL, and a password (Col. 1 lines 15-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Rosenberg and modify it as indicated by Kenner such that the method further comprises receiving registration information from a user, the

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registration information comprising at least one of a user name, an e-mail address, a mailing address, a URL, and a password. One would be motivated to have this as it allows for improved advertising and promoting of goods and services (Col. 1 lines 15-35 of Howard).

### ***Conclusion***

67. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

68. "piiq.com Revolutionizes Online Shopping With New Internet Language", Business Wire, December 3, 1999. p.1137. Discloses a summary of the piii.com system directly related to the Rosenberg patent. Last paragraph notes an official launch date of the piii.com website being August of 1999.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 703-305-4868. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Lazaro  
July 6, 2004



**HOSAIN ALAM**  
**SUPERVISORY PATENT EXAMINER**